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U. S. PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gary Null & Associates, Inc.

Serial No. 75/308,480

Eric D. Offner for Gary Null & Associates, Inc.

Elizabeth Pasquine, Trademark Examining Attorney, Law Office 101
(Jerry Price, Managing Attorney).

Before Hanak, Bucher and McLeod, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant, Gary Null & Associates, Inc., a New York corporation, has filed an application for registration of the mark "HEAVENLY ALOE" for "nutritional supplements, vitamins, mineral supplements; herbal extracts for use as nutritional supplements, and beverage mixtures, namely nutritional drink mixes for use as meal replacements" in International Class 5.¹

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, "HEAVENLY ALOE," when used on its nutritional products, so resembles the registered

mark, "HEAVENLY STRAWBERRY BANANA," for "fruit juices, fruit juice drinks, lemonades, aerated and non-aerated waters, and carbonated sodas," as to be likely to cause confusion, or to cause mistake, or to deceive.²

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We reverse the refusal to register.

The Trademark Examining Attorney contends that these two marks are structured identically and that the "HEAVENLY ..." formative is distinctive enough to find a likelihood of confusion herein when one examines the registry for goods that are closely related to registrant's goods. Furthermore, the Trademark Examining Attorney points out that the record shows that a number of companies market fruit drinks and nutritional supplements under the same mark. She disputes the claim there has been any demonstration of sophistication among purchasers for these relatively inexpensive goods, and concludes that applicant's assertion of an absence of actual confusion in the marketplace is to be accorded little weight in the context of this *ex parte* proceeding.

Applicant, on the other hand, argues throughout that the words "HEAVEN" and "HEAVENLY" are quite weak for confectionery,

¹ Serial Number 75/308,480 filed on June 13, 1997 alleging first use on March 12, 1995.

² Registration No. 2,076,679 issued on July 8, 1997. The registration sets forth dates of first use of August 17, 1994.

herbal and food products. Although once conceding that the goods were related, applicant argues in its brief that the respective goods are different. Applicant argues that inasmuch as they are health-conscious consumers, purchasers of its products are discriminating. Moreover, applicant contends that the two marks are substantially dissimilar, and that there has been no actual confusion despite widespread use of applicant's mark.

In the course of rendering this decision, we have followed the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth factors which must be considered, if relevant, in determining likelihood of confusion.

The Goods:

The first du Pont factor we consider is the similarity or dissimilarity and nature of the goods as described in the instant application and the cited registration. Registrant's goods include fruit juices and fruit juice drinks. Given its mark, we would be surprised if registrant's goods did not include drinks derived from strawberry banana juice concentrates, or at a minimum, have as ingredients thereof strawberry banana flavoring.

Applicant's goods include nutritional drink mixtures. The specimens of record tout the health benefits of ingesting aloe

while also emphasizing the cherry flavoring of this drink mix.³ These goods clearly do not have identical properties, and they are not competing products. While registrant's products as described fit squarely into the category of mainstream fruit drinks and carbonated beverages, applicant is marketing a meal replacement product to health-conscious consumers. Hence, we need to determine the precise relationship of applicant's meal replacement drink mixes to registrant's fruit drinks.

Meal replacement drink mixes, such as those sold by applicant, emphasize the health-benefits of the product - for example, that the product contains large portions of the recommended daily intake of essential nutrients, vitamins and minerals, that it is full of protein for weight reduction, that it is high in carbohydrates and low in saturated fats, and that it contains no cholesterol.

The record contains dozens of third-party registrations, which the Trademark Examining Attorney has made of record in order to demonstrate the relatedness of the goods of registrant and of applicant. While the type of health-claims once confined to containers for alternative products have now migrated to the labels of mainstream food and drink items on every aisle of the

³ Although the identification of goods to which we must look in making our conclusions about the relatedness of the goods has no limitations as to flavor (e.g., chocolate, vanilla or fruit flavors), applicant's goods are fruit-flavored. Nonetheless, this alone is hardly sufficient to conclude that these drink mixes are related commercially to registrant's fruit drinks.

supermarket, it would be inappropriate to conclude that fruit drinks and meal replacement drink mixes have merged into a single product category.

In looking at the third-party registrations proffered by the Trademark Examining Attorney, we do see cases where a single registrant uses the same mark on meal replacement drink mixes and goods described as fruit drinks. However, in most of these registrations, all indications are that the two products are indeed very similar in nature. The first listed product is a drink mix where the health-conscious consumer can buy a mix in a powder form or even as a bulk product. The second listed item is simply a liquid version of essentially the same dietary or nutritional product being sold as a drink, or as a shake, within a can or bottle - already constituted and ready to consume.

Perhaps the only third-party mark reflecting a mainstream beverage mark having been extended into the field of meal replacement drinks is the well-known Gatorade symbol:



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As will be seen in the discussion of the similarities and dissimilarities of the respective marks, *infra*, if one were dealing herein with a mark having the strength of the Gatorade

symbol, the outcome would likely be different. That is, provided that the respective goods were being sold under an identical, strong mark (e.g., an arbitrary term, a coined word or a totally arbitrary design), we could under those circumstances find that these two goods are indeed close enough to support a likelihood of confusion.⁵

Channels of trade:

⁴ Reg. No. 1,852,801, for meal replacement drinks as well as for fruit drinks.

⁵ We are faced with the question of how best to handle the apparent concession of applicant's attorney on March 16, 1998 - very early in the prosecution of this application - as to the similarity of the goods herein. In response to the very first refusal under Section 2(d), applicant's attorney stated: "My arguments are directed to the first step only [difference in the marks], conceding the similarity of the goods." Until filing the appeal brief, applicant's attorney never argued that the goods were different, but in its appeal brief of January 28, 1999, applicant argues the obvious - that the respective goods "are not the same." It is still not clear to us whether this initial concession represented a tactical ploy or a strategic void.

One could argue that applicant's initial position on this issue constitutes a waiver of the argument eventually made in the brief as to the difference in the goods. If one were to hue to this arguable position, then any distance we might find between the goods should not be a factor in reversing the Trademark Examining Attorney. Otherwise, if applicant's attorney had not taken this position throughout the prosecution of this case, the Trademark Examining Attorney may have adduced additional or even more persuasive evidence showing the relatedness of the goods. Most importantly, the outcome herein depends upon a combination of the dissimilarities in the marks *combined* with the differences in the nature of the goods.

While we may find ourselves unhappy with applicant's counsel for having taken this approach, we should stress that this Board strives to reach the correct result under the Trademark Statute, based upon the entire record - even in a case where we find ourselves critical of applicant's counsel's gambit in offering this concession prematurely and then apparently withdrawing it.

Perhaps we would have found a waiver of the "different-goods" argument and reached a different result if the Trademark Examining Attorney had not, despite this early concession, quite correctly availed herself of the opportunity to adduce some additional evidence on this important point during the course of prosecution.

We turn next to the similarity or dissimilarity of established, likely-to-continue trade channels. The Trademark Examining Attorney concludes that the goods of registrant and of applicant would be sold in the same channels of trade. While both items may be sold in the same supermarket, there is no evidence to conclude that they are sold in the same sections or aisles of most markets. Applicant's product will likely also find shelf space in alternative channels of trade, such as specialty or health food stores - a venue we have no reason to believe is critical to registrant. While this du Pont factor seems to support our conclusion above that the goods are somewhat different, there is an insufficient amount of direct evidence in the file to score this factor in favor of the position of applicant or of the Trademark Examining Attorney.

The Marks:

For this critical du Pont factor, we turn to the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. Under Section 2(d) of the Act, we must compare applicant's "HEAVENLY ALOE" mark to registrant's "HEAVENLY STRAWBERRY BANANA" mark.

Obviously these two marks begin with the same word "HEAVENLY." This provides for some degree of similarity as to the appearance and pronunciation of the first three syllables of each mark. However, it can hardly be argued that the short, two-

syllable "ALOE" portion of applicant's mark has much resemblance as to overall sight and sound to the much longer, six-syllable "STRAWBERRY BANANA" portion of registrant's mark.

With respect to the similarity in the meaning of the marks, it is the position of the Trademark Examining Attorney that both trademarks convey similar commercial impressions. This position appears to be based on the fact that both marks contain the identical term "HEAVENLY," and that the additional words "ALOE" in applicant's mark and "STRAWBERRY BANANA" in registrant's mark are each disclaimed as descriptive of the respective products.

We disagree with the Trademark Examining Attorney's conclusion on this critical question. As part of its evidentiary record, applicant has submitted a very large number of third-party registrations of "HEAVEN" and "HEAVENLY" marks for food and beverage items. While there is no evidence in the record of the actual use of any of these third party marks, and hence no showing of public awareness of individual marks, we are most comfortable using these registrations as one might use dictionary definitions to show that a term has a particular meaning within a specific industry. See The Conde Nast Publications, Inc. v. Miss Quality, Inc., 507 F.2d 1404, 184 USPQ 422 (CCPA 1975). In this case, the numerous registrations for "HEAVENLY ..." formative marks in the area of food and beverage items show that the word "HEAVENLY" is a suggestive term, not an arbitrary word, for these food and

beverage items. Merchants and manufacturers who apply marks incorporating "HEAVEN" or "HEAVENLY" to edible goods seek to capitalize on the suggestive connotation of the consumer eating or drinking things that are "wonderful" or "delightful." Hence, we must approach with caution the argument that the inclusion in the two marks of the word "HEAVENLY" alone is a sufficient basis upon which to find likelihood of confusion. That is, we find that consumers are unlikely to ascribe a common source to all food and beverage items based solely on the fact that the goods are being sold under marks that include in common the word "HEAVENLY."

As noted above, applicant's mark and registrant's mark both begin with the word "HEAVENLY ..." followed by descriptive wording. The Trademark Examining Attorney points out that in the registered mark, the term "STRAWBERRY BANANA" is disclaimed, as is the word "ALOE" in the instant application. If the goods were more closely related and the common prefix for these two marks were stronger, we would agree with the Trademark Examining Attorney that the other wording in applicant's mark is less prominent than the word "HEAVENLY" - given the descriptive nature of the word ALOE.

However, as used in these two marks, these respective terms (i.e., "STRAWBERRY BANANA" and "ALOE") do not reflect analogous types of descriptive matter. Registrant's entire mark, "HEAVENLY STRAWBERRY BANANA," conjures up images of a luscious, delightful beverage having a popular combination of two fruit flavors. By

contrast, the descriptive, disclaimed portion of applicant's "HEAVENLY ALOE" mark does not focus on the flavor of the product. Rather, aloe vera concentrate is derived from the leaves of a plant and the resulting "aloe" is an ingredient of this product. At first blush, many consumers would associate the term "aloe" with a chemical compound found in topical solutions, not with a beverage.⁶ Hence, consumers in the market for this specialized product are likely to view "HEAVENLY ALOE" as connoting, at best, a palatable way to ingest a component not known for its delightful flavor. As such, in spite of the fact that it is descriptive of an ingredient of applicant's product, the "ALOE" component of applicant's mark may well lend greater source-indicating significance to this composite mark (than is the case with registrant's suffix portions) precisely because of the seeming incongruity of such a mark applied to a food or drink product.

Hence, in addition to the obvious dissimilarities as to appearance and pronunciation pointed out above, we conclude based upon our analysis that the marks convey quite different meanings

⁶ The specimens of record reflect this tension between the "delightful" connotation of the prefix of this mark for a "very cherry-berry" product, and the bitter or undesirable connotations of ingesting aloe:

The Heavenly Aloe Blend That Tastes Delicious!

Gary Null's Heavenly Aloe is the first aloe blend that actually tastes delicious! This special whole leaf aloe vera concentrate is made using a patented technique of "whole leaf processing" which removes the undesirable aloin and aloe emodin. The result is a blend that maximizes the availability of vitamins, minerals, amino acids, enzymes, mucopolysaccharides and over 200 nutrients contained in the whole leaf aloe. And it tastes so good, you'll look forward to drinking your aloe!

and project different commercial impressions. Thus, we conclude that when the marks "HEAVENLY ALOE" and "HEAVENLY STRAWBERRY BANANA" are compared in their entireties, they are sufficiently different that consumers are unlikely to believe that they represent a single source for the meal replacement items and mainstream beverages rendered under these respective marks.

Strength of "Heavenly..." marks on similar goods:

Applicant and the Trademark Examining Attorney have spent a great deal of time in examining closely the number and nature of similar marks that may be in use on similar goods as reflected in the federal trademark register.

Applicant argues that "-HEAVEN-" and "-HEAVENLY-" formatives are so weak as applied to food items and beverages that it is the balance of the respective marks which consumers will rely upon to distinguish the source of these goods.

Contrariwise, the Trademark Examining Attorney argues that the word "HEAVENLY" is " ... not weak for the applicant's and the registrant's closely related goods ..."

On the narrow question of just how weak or how strong are "HEAVENLY ... " formatives for food and beverage items, we find that the trademark register suggests the truth is somewhere between these two extreme characterizations.

On the one hand, applicant would have us lump together more than fifty, third-party marks for herbal remedies, food

supplements, food items and beverage items because they all contain linguistic links to "Heaven" or "Heavenly." Applicant casts its net so broadly that its list of federal registrations includes a number of third-party marks comprising loose English translations of Chinese characters, or words borrowed from a native Hawaiian language.

Furthermore, a majority of the English-language marks listed by applicant do not even contain the adjective, HEAVENLY, but, in fact, merely contain within them somewhere the noun form "HEAVEN." Many of these third-party marks project connotations vastly different from 'food or beverage items having wonderful or enchanting flavors' - rather they comprise suggestions of a celestial abode for God and the angels (e.g., "SEVENTH HEAVEN," "TASTE OF HEAVEN," "HEAVEN TEMPLE"). Yet others, like "HEAVEN HELP ME," represent our everyday idiom - again having very different connotations than those of a celestial abode or of gastronomic delights. And the several "ALMOST HEAVEN" marks may call to mind for some the late John Denver singing wistfully of our neighboring state of West Virginia.

In point of fact, many of the "-HEAVENLY-" formatives (like the trademarks we discussed, *supra*, having "-HEAVEN-" prefixes or suffixes) also emphasize a commercial impression directed to popular visions (or perhaps even caricatures) of the hereafter

(e.g., "HEAVENLY GARDENS," "HEAVENLY DELIGHTS," "HELL SAUCE, IT'S HEAVENLY and burning caldron design," etc.).

In any case, marks containing the word "HEAVENLY" certainly do not make up the strongest marks on the register - especially as applied to food items.⁷ However, perhaps even among beverages, "HEAVENLY ..." formatives may not be as strong as argued by the Trademark Examining Attorney. For example, the record reveals third-party registrations like "HEAVENLY" for coffee and "THE HEAVENLY TEA" for tea. Hence, given the widespread usage of this suggestive matter, the scope of protection for "HEAVENLY ..." formative mark, even as applied to beverages, is extremely narrow. On the other hand, it would also be wrong to conclude from our decision reversing the Examining Attorney that "HEAVENLY ..." formatives have absolutely no source-indicating abilities as applied to foods and beverages. Rather, others marketing liquid dietary or nutritional supplements and/or mainstream beverages should be on notice as to the uncertainty and risk of adopting and using an admittedly weak word HEAVENLY, especially if it connotes the delightful flavor of these products. One might still run afoul of the distinct niches carved out by applicant, who has done this for meal replacement, nutritional drink mixes, or that carved out by registrant, who has done this for fruit drinks.

⁷ Given the arguably dilute nature of this matter for a wide variety of foods, similar marks for salad dressing, ham, canned peaches, baked goods, etc., are not all that relevant to our decision herein, given the more significant differences in these goods.

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Fame of registered mark:

Given the nature of an *ex parte* proceeding, we have no information about the fame of registrant's mark. On the other hand, if this question were to be raised in the context of an *inter partes* proceeding, where registrant could put forward evidence as to sales, advertising, length of use, etc. demonstrating, for example, that "HEAVENLY STRAWBERRY BANANA" is well-known and hence a strong mark, this tribunal may well reach the opposite conclusion as to likelihood of confusion. If the registered mark were shown to be famous, for example, we might well conclude that consumers would be so familiar with "HEAVENLY STRAWBERRY BANANA" that they would assume that another "HEAVENLY ..." mark, including one like "HEAVENLY ALOE," is associated with the same source.

Conditions under which sales are made:

We turn next to a discussion of the conditions under which and buyers to whom sales are made, i.e. "impulse" shopping versus careful, sophisticated purchasing.

Despite the declaration of Mr. Gary Null, president of applicant, we cannot assume that all of applicant's purchasers "... are typically discriminating health-conscious consumers who purchase such products after careful consideration of the product and its attributes." Rather, by conducting her own mathematical

calculation from Mr. Null's declaration (e.g., \$2 million in sales represents 150,000 units), the Trademark Examining Attorney concludes that a liter of this concentrate cost, at retail, around thirteen dollars. Furthermore, if a single serving comprises two tablespoons of concentrate (before being mixed with water or another drink), we calculate that a one-liter container of concentrate should make about thirty-five servings, each costing the consumer less than forty cents to replace an entire meal. Hence, we agree with the Trademark Examining Attorney that these are relatively inexpensive goods. In reviewing the conditions under which and buyers to whom sales are made, we must conclude that these nutrition supplements are indeed sold to ordinary consumers. In any event, presumably even health-conscious consumers are likely to be confused if two highly similar marks were to be applied to the same or closely related products.

Absence of Actual Confusion:

We turn next to the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion. Our conclusion herein that confusion is not likely is not significantly bolstered by the absence of any reported incidents of actual confusion during a period of three years of contemporaneous use by the parties of their respective

marks.⁸ This is true because the absence of any instances of actual confusion is a meaningful factor only where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or both of these trademark owners. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). In this case, a three-year period is a relatively short interval. Just as significantly, we have not had opportunity to hear from the registrant on this point. Therefore, Mr. Null's claim that no instances of actual confusion have been brought to his attention is not indicative of an absence of a likelihood of confusion, and this factor favors neither the position taken by applicant nor that of the Trademark Examining Attorney.

Conclusion:

Taking our review of all the relevant du Pont factors into consideration, we agree with the Trademark Examining Attorney that these products are directed to ordinary, not sophisticated, consumers; that the absence of any actual confusion is of little significance in our decision-making; and that the registry does

⁸ From March 1995 until Mr. Null's declaration of September 1998.

not support a conclusion that "HEAVENLY ..." marks are totally dilute in the field of food and beverages.

Yet, when one focuses on the real differences between the respective goods, combined with the dissimilarities in the marks, we cannot agree with the Trademark Examining Attorney that consumers are likely to believe that "HEAVENLY ALOE" fruit flavored concentrates with nutritional properties designed to be mixed with water emanate from the same source as the registrant's "HEAVENLY STRAWBERRY BANANA" fruit juice drinks.

Decision: The refusal to register is hereby reversed.

E. W. Hanak

D. E. Bucher

L. K. McLeod

Administrative Trademark
Judges, Trademark Trial and
Appeal Board